

### **REMARKS**

In the August 9, 2007 Office Action, claims 1-10, 13-15 and 17-19 stand rejected in view of prior art, while claims 11, 12 and 20 were indicated as containing allowable subject matter. Claim 16 is believed to be allowable since claim 16 was indicated as containing allowable subject matter in the February 5, 2007 Office Action and rewritten in independent form to accept the allowable subject matter in the response filed on May 24, 2007. No other objections or rejections were made in the Office Action.

#### ***Status of Claims and Amendments***

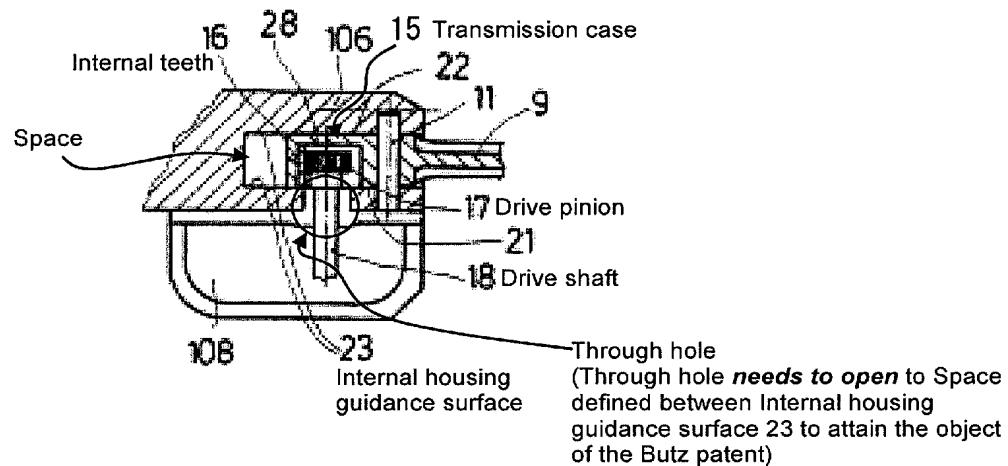
In response to the August 9, 2007 Office Action, Applicants have amended claims 1, 3, 11-13, 17, 19 and 20 as indicated above. Specifically, Applicants have amended claims 1 and 17 to distinguish the prior art, amended claims 3, 13, 19 in view of the changes to claims 1 and 17 and rewritten claims 11, 12 and 20 in independent form to accept allowable subject matter. Applicants wish to thank the Examiner for this indication of allowable subject matter and the thorough examination of this application. Thus, claims 1-20 are pending, with claims 1, 11, 12, 16, 17 and 20 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

#### ***Rejections - 35 U.S.C. § 103***

In paragraphs 1 and 2 of the Office Action, claims 1-10, 13-15 and 17-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,199,997 to Isobe (hereinafter "Isobe patent") in view of DE Patent No. 4340471 to Butz (hereinafter "Butz patent"). In response, Applicants have amended independent claims 1 and 17 as mentioned above.

More specifically, independent claims 1 and 17 now clearly recite that a motor unit

mounting portion is configured and arranged to be coupled to a motor unit, and that the motor unit mounting portion includes an *output shaft cutout* disposed at a location *spaced apart from the link receiving space* such that an *output shaft* of the motor unit is *offset from the link receiving space* when the output shaft is disposed in the output shaft cutout. This arrangement is disclosed in Figures 12 and 13, for example, of the subject application. Clearly this arrangement is *not* disclosed or suggested by the Isobe patent, Butz patent or any other prior art of record.



Annotated Figure 4 of Butz patent

Specifically, the Isobe patent does *not* disclose or suggest a motor unit mounting portion configured and arranged to be coupled to a motor unit, as acknowledged in the Office Action. Furthermore, referring to the annotated Figure 4 above, the Butz patent merely discloses a through hole for a drive shaft 18, which is formed on one of internal housing guidance surfaces 23 and communicated with a space defined between the internal housing guidance surfaces 23. However, the through hole of the Butz patent does *not* disposed at a location *spaced apart from the space* defined between the internal housing guidance surfaces 23. Moreover, referring to col. 1, lines 59-64 and a translation of the abstract of the Butz

patent, an object of the Butz patent is sealing the transmission case 15 with internal teeth 16 sufficiently by disposing the transmission case 15 in the space defined between the internal housing guidance surfaces 23. Furthermore, the internal teeth 16 mates with a drive pinion 17 on a drive shaft 18 which is inserted to the space defined between the internal housing guidance surfaces 23. Thus, to attain the object of the Butz patent, the through hole for the drive shaft 18 needs to open to the space defined between the internal housing guidance surfaces 23. Therefore, one of ordinary skill in the art would *not* combine the Isobe patent with the Butz patent to obtain the arrangement as now recited in claims 1 and 17.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art provides an *apparent reason* for the desirability of the modification. Accordingly, the prior art of record lacks any apparent reason, suggestion or expectation of success for combining the patents to create the Applicants' unique arrangement of a motorized front derailleur mounting member or a motorized front derailleur assembly.

Moreover, Applicants believe that dependent claims 2-10, 13-15, 18 and 19 are also allowable over the prior art of record in that they depend from independent claims 1 and 17, and therefore are allowable for the reasons stated above. Also, dependent claims 2-10, 13-15, 18 and 19 are further allowable because they include additional limitations. Thus, Applicants believe that since the prior art of record does not disclose or suggest the invention as set forth in independent claims 1 and 17, the prior art of record also fails to disclose or suggest the inventions as set forth in dependent claims 2-10, 13-15, 18 and 19.

Therefore, Applicants respectfully request that this rejection be withdrawn in view of the above comments and amendments.

Appl. No. 10/786,153  
Amendment dated October 30, 2007  
Reply to Office Action of August 9, 2007

***Allowable Subject Matter***

In paragraph 3 of the Office Action, claims 11, 12 and 20 were indicated as containing allowable subject matter. Applicants wish to thank the Examiner for this indication of allowable subject matter and the thorough examination of this application. In response, Applicants have amended claims 11, 12 and 20 to place them in independent form. Thus, independent claims 11, 12 and 20 are believed to be allowable.

Furthermore, claim 16 is also believed to be allowable since claim 16 was indicated as containing allowable subject matter in the February 5, 2007 Office Action and rewritten in independent form to accept the allowable subject matter in the response filed on May 24, 2007.

***Conclusion***

In view of the foregoing amendment and comments, Applicants respectfully assert that claims 1-20 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

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Dated: October 30, 2007

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